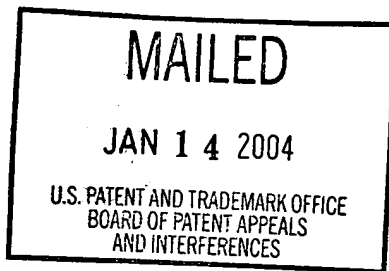


The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RICHARD HILICKI
and
HAROLD ANDERSON

Appeal No. 2004-0304
Application No. 09/606,426

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6, 8, 10 to 33, 35, 37, 39 to 58, 60, 61, 63 and 65 to 68, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to displays for collecting coins (specification, p.

1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claims 1 and 44, the independent claims on appeal read as follows:

1. A book having a theme and capable of displaying one or more coins related to the theme, comprising:
 - a first book cover;
 - a second book cover joined to said first book cover, wherein the exterior of at least one of said first and second book covers defines one or more coin receivable apertures, wherein an image related to the book theme is displayed in at least one or more of said one or more coin receivable apertures, and wherein the book theme is displayed on at least one of said first and second book covers; and
 - a plurality of sheets fastened together and attached to at least one of said first and second book covers, and wherein at least one of said plurality of sheets provides pre-printed information related to the book theme.
44. A method of making a book having a theme and capable of displaying one or more coins related to the theme comprising:
 - providing a first book cover;
 - joining a second book cover to said first book cover, wherein the exterior of at least one of said first and second book covers defines one or more coin receivable apertures, wherein an image related to the book theme is displayed in at least one or more of said one or more coin receivable apertures, and wherein at least one of said first and second book covers displays the book theme; and
 - attaching a plurality of sheets fastened together to at least one of said first and second book covers, wherein at least one of said plurality of sheets provides pre-printed information related to the book theme.

Claims 1 to 6, 8, 10 to 33, 35, 37, 40 to 58, 60, 61, 63 and 65 to 68 stand rejected under 35 U.S.C. § 103 as being unpatentable over "The 50 States Quarters" by Miller et al.¹ (Miller).

Claim 40 stands rejected under 35 U.S.C. § 103 as being unpatentable over Miller in view of U.S. Patent No. 3,217,866² to Phelps.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 13, mailed April 18, 2002) and the answer (Paper No. 16, mailed December 24, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed October 17, 2002) and reply brief (Paper No. 17, filed February 24, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of

¹ Published by Tangerine Press; 1999; ISBN 0-439-20822-X.

² Issued November 16, 1965.

all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 6, 8, 10 to 33, 35, 37, 39 to 58, 60, 61, 63 and 65 to 68 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejections under appeal, the examiner and the appellants agree that while Miller discloses a coin book having a theme Miller does not disclose that the exterior of at least one of the first and second book covers defines one or more coin receivable apertures and that an image related to the book theme is displayed in at least one or more of the one or more coin receivable apertures. To make up this shortcoming in the disclosure of Miller, the examiner (final rejection; pp. 3-4) concluded that these

differences would have been obvious to one having ordinary skill in the art at the time the invention was made since it has been held that rearranging parts of an invention involves only routine skill in the art citing to In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). The appellants argue throughout both briefs that the applied prior art does not suggest modifying Miller to arrive at the claimed subject matter.

In our view, the examiner's determination of the obviousness of the subject matter of claims 1 and 44 has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002); In

re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). In this case, there is no evidence providing any suggestion or motivation for an artisan to have modified the teachings of Miller to arrive at the subject matter of claims 1 and 44. The examiner's reliance on Japikse is misplaced for the reasons stated by the appellants in the briefs. In short, Japikse does not provide a general rule that rearranging parts of an invention involves only routine skill in the art. Each case must be decided on its own facts and in this case the examiner has not established a prima facie case of obviousness with respect to the claims under appeal for the reasons set forth above. Accordingly, the decision of the examiner to reject independent claims 1 and 44, and claims 2 to 6, 8, 10 to 33, 35, 37, 39 to 43, 45 to 58, 60, 61, 63 and 65 to 68 dependent thereon, under 35 U.S.C. § 103 is reversed.³


³ We have also reviewed the patent to Phelps additionally applied in the rejection of claim 39 (dependent on claim 1) but find nothing therein which makes up for the deficiencies of Miller discussed above regarding claim 1.


CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8, 10 to 33, 35, 37, 39 to 58, 60, 61, 63 and 65 to 68 under 35 U.S.C. § 103 is reversed.

REVERSED


IRWIN CHARLES COHEN
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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